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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Marc O. Schurr

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EXAMINER

EREZO, DARWIN P

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/957,451	<b>Applicant(s)</b> SCHURR ET AL.	
	<b>Examiner</b> DARWIN P. EREZO	<b>Art Unit</b> 3773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Disposition of Claims: Claims pending in the application are 1,2,4,5,7,120,121,124,126,127,129-132,134,135,137,138,140,142-145,147-155,157,164-167 and 172-179.

Continuation of Disposition of Claims: Claims rejected are 1,2,4,5,7,120,121,124,126,127,129-132,134,135,137,138,140,142-145,147-155,157,164-167 and 172-179.

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/18/07 has been entered.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 4, 7, 120, 121, 129, 134, 135, 137, 142, 147-150, 157, 164-167, 172, 174, 176 and 178 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,620,452 to Yoon.

(claims 1, 120, 135 and 148) Fig. 8 of Yoon discloses a clip that is fully capable of securing a fold of tissue for treating GERD, the clip comprising:

a first arm **16**;

a second arm **18** disposed substantially opposite from each other,

wherein the first and second arms have a first (proximal) end fixedly connected to each other to define an opening that is capable of receiving a fold of tissue (see Fig. 8),

wherein the first and second arms extend substantially in the same direction as the fold of tissue (see Fig. 8),

wherein the opening allows tissue to extend beyond a second end of the first and second arm (the arms of the clip shown in Fig. 8 do not have an end retaining portion on its free end and will operate substantially similar to the clips shown in Figs. 14-15),

wherein the second end of the first and second arms are capable of maintaining a non-contacting relationship when in a deployed stated (the free ends of the arms of the clip do not have retaining portion and will operate substantially similar to the clips shown in Figs. 14-15),

wherein the second end of the first arm is configured to maintain a non-contacting relationship with the second end of the second arm when the device is in an initial, normal position (Fig. 8),

wherein the clip can be made of bioabsorbable material (col. 3, ll. 8),

wherein the second arm **18** includes integral anchoring portions **50**, which are projections that are capable of maintaining a non-contacting relationship with the other of the first and second arms during a deployed state,

wherein the first and second arms are comprised of bioabsorbable material such that the entire clip, including the first and second arms, is capable of disintegrating in a body (col. 3, lines 40-41), and

wherein the clip is fully capable of being inserted through an esophagus.

(claim 2) The first and second arms are fully capable of frictionally engaging an outer surface of a tissue fold.

(claim 4) The clip shown in Fig. 8 has two protruding anchoring portions **50** with cooperating fixation holes **36**.

(claims 7, 134, 147 and 157) The first arm and second arm forms a substantially U-shaped configuration (see Fig. 8).

(claim 121) The anchoring portion is fully capable of engaging a fold of tissue therebetween.

(claims 137, 149, 150) The anchoring portion **50** is a projection barb located on the second arm

(claim 129 and 142) Fig. 8 shows a clip with multiple anchoring portions that are capable of piercing tissues.

(claims 164-167) A clip made of bioabsorbable material does not require removal.

(claims 172, 174, 176 and 178) The anchoring portion **50** is viewed as a barb that is capable of penetrating tissue.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

Art Unit: 3773

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claims 5, 130-132, 143-145, 153-155, 173, 175, 177 and 179 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoon, as applied in the rejections above, and in view of US 3,032,039 to Beaty.

With regards to claims 5, 131, 132, 144, 145, 154 and 155, Yoon discloses all the limitations of the claims except for the distal ends of the first and second arm having a tab. However, the use of tabs on a distal end of surgical clips are well known in the art, as disclosed by Beaty (see Figs. 1-3). The tabs allow the clips to be manipulated by an applicator. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Yoon to have distal end tabs because it would allow the clips to be manipulated into position by an applicator similar to the one shown in Fig. 5 of Beaty.

With regards to claims 130, 143 and 153, it is noted that the addition of the tabs provide a tapering portion on both arms that curves away from the gap.

With regards to claims 173, 175, 177 and 179, it is noted that the addition of the tabs to the to both arms provides a crook between the intersection of the arms and the tabs, which allows the clip to be pushed together.

7. Claims 124, 126, 127, 138, 140, 151 and 152 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoon, as applied in the rejections above.

Yoon discloses all the limitations of the claims except for the projection being a reverse angle barb, or wherein the anchoring portions are located on both the first and second arms. However, it would have been an obvious matter of design choice to have the projection **50** be a reverse angle barb instead of a straight barb since it has been held that changing the shape of a working part involves only routine skill in the art. *In re Dailey*; 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

With regards to the projections extending from both arms, it is noted that Yoon discloses another embodiment wherein the projections are extending from both arms (see Fig. 13). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the projections extending from both arms since Yoon discloses that such arrangement performs the same function of securing the clip to the tissue. Furthermore, it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950).

### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1, 2, 4, 5, 7, 120, 121, 124, 126, 127, 129-132, 134, 135, 137, 138, 140, 142-145, 147-155, 157, 164-167 and 172-179 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DARWIN P. EREZO whose telephone number is (571)272-4695. The examiner can normally be reached on M-F (8:00-4:30).



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Darwin P. Erez/  
Primary Examiner, Art Unit 3773